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EXAMINER	
CARLSON, JEFFREY D	
ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
01/14/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/772,244	BARIK ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2009 and 28 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *See Continuation Sheet* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4,5,7,15,16,18,19,22-27, 30-31,33-35,49-54, 57,59-62,64,66,67,69 and 70.

Continuation of Disposition of Claims: Claims rejected in the application are 1,2,4,5,7,15,16,18,19,22-27, 30-31,33-35,49-54, 57,59-62,64,66,67,69 and 70.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 10/6/2009. This response amended claim 62 so as to overcome the previous 101 rejection. Applicant noted that the previous action listed claims 67, 69 and 70 as rejected, yet noted that no separate section was provided that explained the rationale for the rejection. This has been corrected below. Also some of the repeated alternative rejections failed to include the proper collection of references names. This has been corrected below (Fajkowski in view of Marmon and Beach et al, Fajkowski in view of Wilkman, Marmon and Beach et al). Lastly the action included claim 21 in certain rejection statements, yet because claim 21 had been canceled, this has been corrected. The office action below is otherwise essentially the same as the previous office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61, 62, 66, 67, 69, 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270)**.

4. Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting

them at a retail POS and redeeming them. A user is provided with a card which provides a userID [4:6-81]. The card is used to associate selected coupons from a plurality of available coupons from different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:I-5,6:22-251. When the card is presented at the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, “before purchase”), the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-35]. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items required, expiration) may be stored on the card in order to determine applicable coupons at the POS against the parameter requirements [10:17-26]. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-22] and that certain coupons also may provide benefits of monetary discount, loyalty points and freebies [spec pg 2 lines 14-19]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of eligible coupons, including those with exclusivity rules and those without. Examiner will now address the limitations associated with checking if eligible coupons also meet optimization parameters. Applicant has admitted

that customers frequently have a collection of eligible coupons from which to choose, leaving the consumer with the task of determining which subset of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult in certain situations [spec pg 2 lines 11 -19]. Historically, checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. One of ordinary skill would consider it to be a matter of good customer service for a checkout clerk to assist a customer regarding which coupons could be used (i.e. eligibility) as well which subset of coupons would most benefit the customer for example helping a customer who asks "which coupon(s) would' save the most money?" and/or “which of these coupons should I use quickly before they expire” There should be no doubt that consumers frequently use coupons in order to get the best savings. It would have been obvious to one of ordinary skill at the time of the invention to have provided assistance to customers faced with navigating the recognized (albeit in some cases difficult or confusing) coupon rules and options imposed by the retailer. Fajkowski's system accomplishes the automated eligibility determination in the manner of an Expert System (a computer system programmed to replace a human clerk having the knowledge to determine eligibility for the universe of participating coupons and their restrictions/parameters). Fajkowski's system is also quite intelligent in that it can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. This is another example of

an Expert System capability. Fajkowski's system has been argued to lack presentation to the consumer of a subset of all eligible coupons according to price optimization, yet it would have been obvious to one of ordinary skill at the time of the invention to have provided this desired but heretofore manual capability in an automated manner. See Automating a manual activity -MPEP 2144.04(111). In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In the same manner as outlined in rationale F of KSR, it would have been obvious to one of ordinary skill at the time of the invention to have updated the known invention of Fajkowski with modern automated improvements in order to gain the commonly understood benefits of such adaptation. All this would be accomplished with no unpredictable results.

As stated in ***Leapfrog,*** "applying modern electronics to older mechanical devices has been commonplace in recent years." **Leapfrog Enterprises, Inc. v. Fisher-Price, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007).**

Regarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14-41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons. It would have been obvious to one of ordinary skill at the time of the invention to have recalled saved coupons or a combination of saved coupons for

later consideration (i.e. for future comparison). It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) recommendations to have included coupons that had been "saved". Further still, Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the invention to have recommended this additional coupon even if this is a coupon that had been previously saved.

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [I9:38-431. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-231 when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claim 7, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [I9:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [I 3:5-7, 17:48-631. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Regarding claims 67, 69, 70, when the proposed-as-obvious system/method considers as input the user's determined collection of e-coupons, and determines an output of an optimized coupon/coupon set to suggest for redemption, it can be said that such an optimization process is limited by "parameters" of: which coupons to include as consideration for optimization (each specific coupon the user possesses electronically and the parameters of those coupons – benefit, productID, restrictions, etc.,), the expiration of the coupons (it would have been obvious to one of ordinary skill at the time of the invention to have ignored expired coupons) and the total number of coupons used (i.e. to consider the total quantity of coupons possessed by the user).

Claims 34, 60, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Beach et al (US200210107738).

Regarding claims 34, 60, 64, Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61, 62, 66, 67, 69, 70 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270) in view of Marmon (1184446528).

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting them at a retail POS and redeeming them. A user is provided with a card which provides a ,userID [4:6-81. The card is used to associate selected coupons from a plurality of available coupons from 'different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:1-5, 6:22-251. When the card is presented at the POS along with products to be purchased, the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's potential purchases; the system displays these coupons on the display [I6:18-31, 17:31-33,4:25-351. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items required, expiration) may be stored on the card in order to determine applicable coupons at the POS [I 0:17-261. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-22]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of eligible coupons, including those with exclusivity rules. Examiner will now

address the limitations associated with checking if eligible coupons also meet optimization parameters. Applicant has admitted that customers frequently have a collection of eligible coupons from which to choose, leaving the consumer with the task of determining which subset of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult in certain situations [spec pg 2 lines 11-19]. Historically checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-601. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase requires an understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-221. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the automated eligibility determination and it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the

coupon rules and options imposed by the retailer. This would enable the customer to most benefit from his coupons, deliver the lowest prices as is generally desired as well as encourage purchasing of retailer products. Regarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14-41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons. It would have been obvious to one of ordinary skill at the time of the invention to have recalled saved coupons or a combination of saved coupons for later consideration (i.e. for future comparison). It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) recommendations to have included coupons that had been "saved". Further still, Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the

invention to have recommended this additional coupon even if this is a coupon that had been previously saved.

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [19:38-431. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-231 when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claims 7, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [19:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [13:5-7, 17:48-631. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Regarding claims 67, 69, 70, when the proposed-as-obvious system/method considers as input the user's determined collection of e-coupons, and determines an output of an optimized coupon/coupon set to suggest for redemption, it can be said that such an optimization process is limited by "parameters" of: which coupons to include as consideration for optimization (each specific coupon the user possesses electronically and the parameters of those coupons – benefit, productID, restrictions, etc.,), the expiration of the coupons (it would have been obvious to one of ordinary skill at the time of the invention to have ignored expired coupons) and the total number of coupons used (i.e. to consider the total quantity of coupons possessed by the user).

Claims 34, 60, 64 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Marmon and Beach et al (US200210107738).

Regarding claims 34, 60, 64, Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

5. **Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61, 62, 66, 67, 69, 70 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270) in view of Wilkman (US20020013728).**

6. Wilkman 2002/0013728 enjoys benefit of earlier provisional 60/220637 filed 7/25/2000. Examiner will be referring throughout this office action to the page and line number of 60/220637 as evidence of previous support even though the rejection is being made using the 2002/0013728 reference.

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting them at a retail POS and redeeming them. A user is provided with a card which provides a userID [4:6-81. The card is used to associate selected coupons from a

plurality of available coupons from different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:I-5,6:22-251. When the card is presented at the POS along with scanned products to be purchased (i.e. before the purchase is completed by way of accepting payment - and therefore, “before purchase”), the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's scanned products; the system displays these coupons on the display [16:18-31, 17:31-33,4:25-351. Fajkowski teaches that the coupon eligibility parameters (product name, required size, quantity or combination of items required, expiration) may be stored on the card in order to determine applicable coupons at the POS [10:17-261. Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter often used [spec page 1 lines 21-22] and that certain coupons also may provide benefits of monetary discount, loyalty points and freebies [spec pg 2 lines 14-19]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon. Doing so would enable the system to process and accurately display a wide variety of eligible coupons, including those with exclusivity rules. Examiner will now address the limitations associated with checking if eligible coupons also meet optimization parameters. Applicant has admitted that customers frequently have a collection of eligible coupons from which to choose, leaving the consumer with the task of determining which subset of eligible coupons will provide optimum benefit (i.e. optimum price reduction, optimum

loyalty points, optimum freebies). It has been done manually, but it is admittedly difficult ('non trivial' in certain situations [spec pg 2 lines 11 -19]. Historically checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. One of ordinary skill would consider it to be a matter of good customer service for a checkout clerk to assist a customer regarding which coupons could be used (i.e. eligibility) as well which subset of coupons would most benefit the customer for example helping a customer who asks "which coupon(s) would' save the most money?" and/or "which of these coupons should I use quickly before they expire" Fajkowski's system is also not without automation and is quite intelligent in that it can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. Wilkman also recognizes the variety of incentive offers available to purchasing consumers and he teaches the use of a computer-based optimization routine that takes the legwork out of manually analyzing the variety of eligible combinations and benefits (price, coupons, promotions, loyalty, etc.) in order to provide the best benefit for the consumer [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have provided systems and methods that provide assistance to customers faced with navigating the recognized (albeit in some cases difficult or confusing) coupon rules and options imposed by the incentive providers. Rather than take the time and energy to manually track all of the provided options, restrictions and benefits, it would have been obvious to one of ordinary skill at the time of the invention to have provided a computer system to

optimize the 'non trivial' combination of coupon restrictions and benefits, so that the consumer need not be burdened with the research (although it is well accepted that in the past the research has been capably done manually). Regarding the saved coupons, the choosing among them and recommending based on the saved coupons, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips [13:14-41]. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user. Further, the art describes the capability to save any number of coupons which enables saving combinations of coupons. It would have been obvious to one of ordinary skill at the time of the invention to have recalled saved coupons or a combination of saved coupons for later consideration (i.e. for future comparison). It would have been obvious to one of ordinary skill at the time of the invention for the system's coupon(s) recommendations to have included coupons that had been "saved". Further still, Fajkowski's also teaches that the system can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. It would have been obvious to one of ordinary skill at the time of the invention to have recommended the use of saved coupon where the user is close to an optimized coupon eligibility, but needs to make slight changes to his products for purchase. It would have been obvious to one of ordinary skill at the time of the

invention to have recommended this additional coupon even if this is a coupon that had been previously saved.

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [l9:38-431. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-231 when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claim 7, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [I9:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [I 3:5-7, 17:48-631. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Regarding claims 67, 69, 70, when the proposed-as-obvious system/method considers as input the user's determined collection of e-coupons, and determines an output of an optimized coupon/coupon set to suggest for redemption, it can be said that such an optimization process is limited by "parameters" of: which coupons to include as consideration for optimization (each specific coupon the user possesses electronically and the parameters of those coupons – benefit, productID, restrictions, etc.,), the expiration of the coupons (it would have been obvious to one of ordinary skill at the time of the invention to have ignored expired coupons) and the total number of coupons used (i.e. to consider the total quantity of coupons possessed by the user).

Claims 34, 60, 64 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski and Wilkman as above and further in view of Beach et al (US200210107738).

Regarding claims 34, 60, 64, Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Claims 1-2, 4-5, 7, 15-16, 18-19, 22-27, 30-31, 33, 35, 49-54, 57, 59, 61, 62, 66, 67, 69, 70 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski and Wilkman as above and further in view of Marmon (1184446528).

Regarding claims 1-2, 15-16, 27, 30, 54, 57, Marmon teaches that shopping can get quite complicated when pricing systems are combined with cents off coupons and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a calculating tool for optimizing purchasing decisions affected by the complex pricing combinations that include coupons [col 1 lines 50-601. Marmon notes that the consumer is confronted with many price-affecting choices related to coupons and that he usually is seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase

requires an understanding of coupon procedures (i.e. rules) and unit pricing techniques [col 3 lines 20-221. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the automated eligibility determination and it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the coupon rules and options imposed by the retailer. This would .enable the customer to most benefit from his coupons, deliver the lowest prices as is generally desired as well as encourage purchasing of retailer products.

Regarding claims 4, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [19:38-431. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-231 when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 19, 35, 61, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claims 7, the network is described as the Internet.

Regarding claims 22, 23, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. . The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [19:21-251. The POS may be used to display all coupons that were non-compliant [19:44-531; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [13:5-7, 17:48-631. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Regarding claims 67, 69, 70, when the proposed-as-obvious system/method considers as input the user's determined collection of e-coupons, and determines an output of an optimized coupon/coupon set to suggest for redemption, it can be said that such an optimization process is limited by "parameters" of: which coupons to include as consideration for optimization (each specific coupon the user possesses electronically and the parameters of those coupons – benefit, productID, restrictions, etc.,), the expiration of the coupons (it would have been obvious to one of ordinary skill at the time of the invention to have ignored expired coupons) and the total number of coupons used (i.e. to consider the total quantity of coupons possessed by the user).

Claims 34, 60, 64 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski, Wilkman and Marmon as above and further in view of Beach et al (US200210107738).

Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 131. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Response to Arguments

Applicant argues that because Fajkowski is directed to a coupon card, scanner and associated computer processing elements and that applicant's invention is directed to recommending coupons, that it would not be obvious to modify Fajkowski to arrive at the claimed invention. Examiner disagrees. Both are concerned with automated and electronic coupon redemption systems. The claims are obvious for the reasons provided above.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner has addressed previously presented arguments which examiner is repeating herein for a clear understanding of examiner's positions:

Applicant has added some language that clarifies that the invention determines mutually exclusive coupons as well as non-mutually exclusive coupons and can optimize coupon selection by selecting a combination of non-mutually exclusive coupons. Applicant also argues that the claim amendments do not change the scope of the claims. As the examiner has previously made his case why it would have been obvious to one of ordinary skill at the time of the invention to have automated the suggestion of an optimized combination of coupons and as only non-mutually exclusive

coupons can inherently be used in combination, the previous rejection still addresses the current claim set.

Applicant argues that Fajkowski only checks coupons after purchase. This is entirely incorrect. Like applicant, Fajkowski scans products to determine *products under consideration for purchase*, so that the scanned products (not yet purchased) can be compared to the coupons offered for redemption during the purchase. The coupons are certainly not redeemed by the cash register after the purchase is finalized, but before – so that the consumer can reduce *his purchase price*. Fajkowski uses the term purchase data and items purchased to refer to items scanned, but not paid for (i.e. not purchased; i.e. "before purchase"). Applicant points to the top of column 17 of Fajkowski and fig 15a, yet if applicant would consider the bottom of Column 17 and companion figure 15b, he would see that Fajkowski scans products, considers coupons for redemption, then finalized the current purchase.

Applicant argues that because Fajkowski appears to teach certain coupons applicable to the same product but which may not be redeemed together, that Fajkowski teaches away from coupons that can be used together. This is untrue. At best Fajkowski is silent on coupons that may be used together (examiner believes this to be called "stacking coupons"). Applicant admits these types of combinable coupons are well known and as stated in the rejection, it would have been obvious to one of ordinary skill at the time of the invention to have enabled the system of Fajkowski to properly treat such coupons. Applicant's only argument why this is a teaching away is that Fajkowski is concerned with fraudulent redemption. Of course, Fajkowski prevents

stacking coupons when the coupon rules prohibit. However one of ordinary skill would actually find it entirely consistent with Fajkowski's intention of "following the coupons' redemption rules" when stackable coupons are present.

Applicant argues that the claimed system is a very complicated decision-making system and which "might not be able to be performed manually" and performs steps "that could not be performed manually". Examiner will ignore the "might not" argument as it seems to agree with examiner because it also inherently asserts that indeed the decision "might be" capable of being performed manually. When applicant argues the steps "could not be performed" manually, there is no reasoning given other that it can be difficult ("or non-trivial" pg 1 line 21). It is first pointed out that at least some of applicant's claims do not require any automation and therefore they actually read on a manual process. Applicant's claims are not limited in any way to any particular difficult scenarios or decision making – they include the claim scope where the potential combinations of coupons and their resulting benefits are actually rather straightforward. Nonetheless, applicant's system is taken to be programmed essentially by creating a systemic approach to evaluating the coupon redemption combinations. These evaluations can be done manually – and in fact have been done for years by both consumers and POS clerks or POS systems charged with preventing fraudulent redemption as recognized by applicant. Prior to applicant's invention, the coupon combination possibilities (collection of coupon rules) were already 'difficult' at times. And at these times, either the consumer or the clerk would **have** to understand the "difficult" rules in order to properly redeem coupons. Applicant is merely automating

what has been required previously. Applicant has not created a more challenging coupon redemption situation requiring automation to resolve redemption rules, he merely is now choosing to turn to computer automation to resolve old situations - situations that would have been manually resolved without the invention. Further, consider a customer with poor eyesight or poor reading skills or less-than-common math skills. Any helpful merchant or sales clerk would find it obvious help them "navigate" the applicable coupon rules so they can benefit most (discount, loyalty, freebies) – that is simply good customer service.

Applicant argues that the art does not teach a user defining optimization parameters and display of eligible coupons satisfying the criteria. The rejection above addresses the concept that one of ordinary skill would find it obvious that rather than choose the best coupons manually (as admitted has happened in the past), to automate the recognized difficult, and/or time consuming tasks of choosing the best coupon for that user's desires. One of ordinary skill would see that a computer programmed with the coupon rules/restrictions would be a predictably faster, more convenient, and more accurate way to navigate the same steps historically done manually. Further, *KSR* forecloses the argument that a specific teaching is required for a finding of obviousness (citing *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). See Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

8. It was well known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner,* 262 F.2d 91, 95, 120 USPQ 193, 194

(CCPA 1958). In the same manner as outlined in rationale F of KSR, it would have been obvious to one of ordinary skill at the time of the invention to have updated the known invention of Fajkowski with modern automated improvements in order to gain the commonly understood benefits of such adaptation. All this would be accomplished with no unpredictable results.

As stated in ***Leapfrog,*** "applying modern electronics to older mechanical devices has been commonplace in recent years." **Leapfrog Enterprises, Inc. v. Fisher-Price, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007).**

For example, simply automating the steps of coupon selection gives just what one would expect from the otherwise manual steps. In other words, there is no enhancement found in the claimed steps/system other than the known advantage of increased speed, increased accuracy, increased convenience and reduction in human resource(s) to perform/provide the claimed steps/functionality. The end result is the same as compared to the manual method.

Applicant argues that that Marmon teaches a calculation whether it is better (i.e. optimal) whether to use a coupon or not. Applicant then states that therefore Marmon is "unrelated" to the claimed system. Examiner disagrees and it is rather clear that Marmon is actually *closely related* with coupon decision making and suggesting coupon usage that would be optimum for the user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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